UNITED STATES PATENT AND TRADEMARK OFFICE

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10/797,838	03/10/2004	Katrin Reisinger	P04,0025	5666

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EXAMINER
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ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 May 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-4</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-4</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   The Applicant has amended claim 1. Thus, claims 1-4 remain pending and are again

presented for examination.

Response to Arguments

2.   The Applicant's arguments filed 5/2/07 have been fully considered but they are not

persuasive.

3.   The Applicant refers to postal authority-defined product codes in claim 1 and submits,

"The term 'product code' is a term with a specific, well-documented meaning in the context of

mail processing." Furthermore, Applicant submits "FRANKIT: New Generation Digital

Franking" to further describe the product code and its requirements. The Examiner takes the

Applicant's admissions and the submitted document to be admitted prior art, which discloses that

the use of "product codes" has been well known before the time of the instant application.

4.   The Applicant submits the United States, via the USPS, currently does not require such a

product code and that the said product codes designates additional services, beyond basic mailing

such as overnight delivery, registered mail, etc. The Applicant further argues the Schuricht et al.

reference does not concern such governmentally-defined product codes. The Examiner

respectfully disagrees. It is the Examiner's position that the different shipping modes and rate

codes stored in memory as disclosed by the Schuricht patent (Figures 2B and 2C; column 3, lines

19-21 and 42-59) serve the equivalent purpose of the "product code" as described above.

Furthermore, it is important to note that the carrier, i.e. the U.S. Postal Service, sets shipping

rates and modes.

5.   In response to Applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., "automatic

retrieval of the product code for inclusion in the franking imprint" and "...the determination of

the product code proceeds automatically in the 'background' after the user has entered the

appropriate shipping information.") are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuricht et al.,

U.S. Patent No. 5,040,132.

8.   As per claim 1, Schuricht teaches a mail-processing device comprising: a microprocessor

(Schuricht: Figure 1, "1"; column 2, lines 28-39); a keyboard with operating elements connected

to said microprocessor for entering shipping information into said microprocessor (Schuricht:

Figure 1, "2"; column 1, lines 51-53); a working memory accessible by said microprocessor

containing mail-item-related data values (Schuricht: Figures 1, "6" and Figure 2); a

programmable memory and a program memory accessible by said microprocessor (Schuricht:

Figure 1, "6"; column 2, lines 40-44); in at least one of said program memory and said

programmable memory, a first memory area containing a program for evaluating said mail-item-related data values stored in the working memory to cause said mail-item-related data values to be permanently or temporarily stored (Schuricht: column 2, lines 37-44), a second memory area containing a first table for indices respectively assigned to different postal authority-defined product codes, said product codes being ascendingly or consecutively stored in said table in a column and said table having a second column, in parallel with said first column, containing indices for different product descriptions (Schuricht: Figures 2B and 2C; column 1, lines 24-27, "parcel post"; column 3, lines 19-21 and 42-59 – The Examiner interprets the different shipping modes and rate codes to represent the different products. The Examiner notes, the term "parcel post" refers to a shipping method offered by the U.S. Postal Service. The Examiner further notes, it is in the basic knowledge of the skilled artisan that a rate table contains multiple columns and indices.), and a third memory range for storage of a further table for said product descriptions respectively assigned to said indices in said second column (Schuricht: Figure 2A, The Examiner notes, a further table for the said product descriptions can be the receiver address and location code.); and said microprocessor being programmed by said program for evaluating the mail-item-related data values stored in the working memory by accessing said table containing said first and second columns to automatically determine a product code and a product description for said service product, and to supply as an output a text for said product description for generating a printout thereof (Schuricht: column 4, lines 38-51, "Each information block 16 contains the control commands and text information data required for causing the printer to print out the form or forms required for a certain shipping mode.").

9.   As per claim 2, Schuricht teaches the mail-processing device as claimed in claim 1 as

described above. Schuricht further teaches the said microprocessor is programmed to determine

the index for the product code and to locate the index in said further table for said product

description (Schuricht: column 3, lines 60-68; column 4, lines 1-15, "The processor then has to

select this zone conversion table upon entry of the desired carrier and desired shipping mode and

to determine the appropriate zone number based upon the receiver location postal code. With this

zone number, the processor may then determine the transportation rate value as a function of the

entered weight by reference to the applicable transportation rate table.").

10.   As per claim 3, Schuricht teaches the mail-processing device as claimed in claim 1 as

described above. Schuricht further teaches a fourth memory area for storage of an additional

further table containing text strings assigned to the respective indices, and wherein said

microprocessor is programmed by said program to determine a text string from said additional

further table dependent on shipping parameters for said service product and to supply said text

strings in said output (Schuricht: Figure 2C; column 4, lines 30-37 – The Examiner interprets the

supplement portion within memory 15 to be a fourth memory area, which is separate from the

rate table. The Examiner notes, the information located in memory 15 (Figure 2C) is supplied to

a printer (column 4, lines 46-51)).

11.   As per claim 4, Schuricht teaches the mail-processing device as claimed in claim 1 as

described above. Schuricht further teaches the program memory is a permanent memory and

wherein said programmable memory is a semi-permanent memory (Schuricht: column 9, lines

30-43).

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
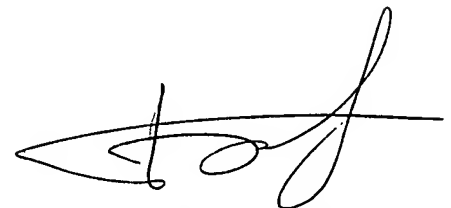
date of this final action.

The Examiner has cited particular portions of the references as applied to the claims

above for the convenience of the applicant. Although the specified citations are representative of

the teachings in the art and are applied to the specific limitations within the individual claim,

other passages and figures may apply as well. It is respectfully requested that the Applicant, in

preparing the responses, fully consider the references in entirety as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The

examiner can normally be reached on Monday - Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER